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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/827,654	04/05/2001	John R. Hindman	ODS-30	6566

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EXAMINER	
NGUYEN, BINH AN DUC	
ART UNIT	**PAPER NUMBER**
3713	

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/827,654	HINDMAN ET AL.
	Examiner	Art Unit
	Binh-An D. Nguyen	3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *5/21/01* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/18/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendment and the Information Disclosure Statements filed March 18, 2004 have been received. According to the Amendment, claims 1, 5-8, 11-15, 20, and 22-24 have been amended; and new claims 25-48 have been added. Currently, claims 1-48 are pending in the application. Acknowledgment has been made.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-14, and 25-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 8, 25, and 32, the recited phrase "a user request for the indicator" lack antecedent basis. Further, this renders the claims vague and indefinite since it is unclear which type of indicator has been requested by the user.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 8-12, 25-29, and 32-36, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Brenner et al. (5,830,068).

Brenner et al. teaches an interactive wagering system and method (and computer readable medium having such method embedded therein) for providing a user with information related to wagering, comprising: means (or step) to give the user the ability to create a wager for a specific race (9:49-60 and 10:3-8); after the user has created the wager, providing the user with an indicator, wherein the indicator is used to indicate to the user availability the information related to the race (9:6-48), and wherein the indicator provided is not in response to a user request for the indicator or user input (the data in menus 206 and 208 and other menus/screen that are used to display racing data are periodically automatically updated to provide the user the most current racing data)(9:49-60); wherein the information is an alert that the race is finished (9:56-67) and an alert that the race has not yet started (Figs. 9 and 10); the indicator is selected from a group consisting of a display overlay (Figs. 9 and 10); means to give the user the ability to obtain additional information on the wager (Figs. 8–12); means to provide the user with the indicator is in response to the user placing the wager that the user created (9:52-60).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 6, 7, 13-24, 30, 31, and 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner et al. (5,830,068) as applied to claims 1-5 and 8-12 above, and further in view of Miller (5,255,915).

Brenner et al. teaches all limitations of claims 1-5, 8-12, 25-29, and 32-36. Brenner further teaches the limitations of providing the user with information related to the race comprises giving the user the ability to place the wager (Figure 12); means (or step) for providing the user with the ability to place the wager before the race (10:62-11:15, Fig. 12); means (or step) for providing the user with the ability to place the wager before the race comprises providing the user with a selectable option (Figs. 8-18); placing the wager in response to the user selecting the selectable option (Figs. 12-15); means (or step) for providing the user with information related to the wager in response to the user selecting the selectable option (2:30-4:42); and wherein the indicator provided is not in response to a user input (the data in menus 206 and 208 and other menus/screen that are used to display racing data are periodically automatically updated to provide the user the most current racing data)(9:49-60).

Brenner et al. does not explicitly teach the limitations of means (or step) for providing to the user the indicator in response to the user neglecting to place the wager (claims 6,13, 30, 37); and means (or step) for providing the user with an indicator wherein the indicator is used to remind the user to place the wager before the race (claims 15, 20, 39, 44).

Miller, however, teaches an interactive video game comprising means (or step) for providing information to the user in response to the user neglecting to place the

wager; and means (or step) for automatically providing the user with an indicator wherein the indicator is used to remind the user to place the wager before the game. See figure and column 4, lines 40-58).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide Brenner et al.'s interactive wagering system and method with the wager detection techniques, as taught by Miller, to enhance wager security in an interactive racing system thus attracts more game players and bring forth profits.

8. Applicant's arguments filed March 18, 2004 have been fully considered but they are not persuasive. Applicants' argument regarding Brenner et al. not teaching the limitation of providing a user with an indicator used to indicate the availability of information related to a race not in response to a user request for the indicator (applicants' remark, pages 19-20), is not well taken. As being defined by the applicant, the user's requested indicator is an indicator in response to user request of the race outcome or wager outcome (applicants' remark, page 19, lines 16-19; and the indicator not in response to the user request is the indicator related to racing information (applicants' remark, page 19, lines 19-22), therefore, Brenner et al.' teaching of the data in menus 206 and 208 and other menus/screen that are used to display racing data are periodically automatically updated to provide the user the most current racing data (9:49-60) would anticipate applicants' claimed limitation of providing a user with an

indicator used to indicate the availability of information related to a race not in response to a user request for the indicator.

In response to applicant's argument that there is no suggestion to combine the references (applicants' remark, pages 22-23, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Brenner et al. teaches an interactive racing wagering system and method for providing a user with information related to wagering wherein the user is given the ability to create a wager for a specific race (9:49-60 and 10:3-8) and after the user has created the wager, providing the user with an indicator to indicate to the user availability the information related to the race (9:6-48), wherein the indicator provided is not in response to a user request for the indicator or user input (9:49-60) while Miller teaches an interactive video game comprising means (or step) for providing information to the user in response to the user neglecting to place the wager and means (or step) for providing the user with an indicator wherein the indicator is used to remind the user to place the wager before the game (see figure and column 4, lines 40-58), therefore, it is obvious to combine Brenner et al.' system and method for providing user the ability to wager a racing game with the wager detection techniques, as taught by Miller, to come up with a racing wager system and method that maximize the number of secured

wagers in a race to enhance wager security in an interactive racing system thus attracts more game players and bring forth profits.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on 703-308-2159. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BN

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